

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Rejections under 35 USC § 112

Claim 1 has been amended to render it clear and distinct and thus overcome the issues raised in paragraph #3 of this Office Action. Claim 5 has been amended to provide proper antecedent basis.

However, in connection with paragraph #4, it is submitted that "calculating candidate rendezvous positions which satisfy the determined criteria" is in fact both clear and distinct. A plurality of positions which are suitable for rendezvous are calculated from available data. Positions, not times and not distances, are calculated irrespective of the fact that both of time and distance could be parameters that are used in the calculation necessary to arrive at the possible rendezvous "positions."

At page 2, lines 11-13, of the originally filed specification, the applicant has exercised his right as a lexicographer and has defined the difference between the terms "position" and "location" as they are used in the specification. The term "location" is used to define an immovable site such as building (viz. , an address) whereas the term "position" on the contrary, has been coined to mean something that is mobile. This difference in meaning is reflected in the usage of these terms in the disclosure spanning page 2, line 14, to page 4, line 13.

What is not appreciated in this rejection, however, is that the delivering party and the receiving part are both on the move. This must be contrasted with the arrangement disclosed in Wood et al. wherein only the delivery entities are mobile and the remainder of the parties involved are, in light of any disclosure to the contrary, static and located for all intents and purposes at the "addresses" disclosed in this reference.

In connection with the assertion that it is not clear how to calculate a position, while it is submitted that this is well within the purview of the person skilled in the art of programming (for example) to develop an algorithm or the like given the need to calculate a number of possible intersect points at which two mobile parties can come together, the rejection misses the point that the rejection is made under the second paragraph of § 112, and that claims are not intended to provide technical disclosure on how a claimed operation is to be carried out but are intended to define the metes and bounds of the scope of protection to which the claimed subject matter is entitled.

In connection with paragraph #6 and the statement contained therein that the claim 1 does not complete the objectives of the preamble, attention is called to the fact that the preamble of the claim has been revised to further clarify said object. That is to say the preamble now calls for “a method for facilitating delivery . . .”

Attention is also called to the US claim format referred to as a “sub-combination.” Indeed, unlike the European claim requirement which calls for a “complete teaching of the invention” to be set forth in what is almost always the one and only apparatus claim, the US permits multiple independent claims which can be either sub-combination or combination type claims. The use of “further comprising” in dependent claims would be rendered essentially impossible and claims such as claim 5 of this application would not be allowed, if the Examiner’s position were to be correct.

It is respectfully submitted that this rejection is without merit and unless an appropriate section of the MPEP or suitable case law can be cited to support this position, it should be withdrawn along with the rejections advanced in paragraphs #3 and #4.

#### Rejection under 35 USC § 101

This rejection is based on the position that an electrical signal is a “non-tangible object” which is not being received or transmitted. This position is traversed.

First, in *In re Beauregard* 53 F.3d 1583 (Fed. Cir. 1995) it has been established that a signal carried on a suitable medium does in fact constitute statutory subject matter.

Second: an electrical signal is tangible. The Merriam-Webster Online Dictionary defines tangible as:

- 1      a : capable of being perceived especially by the sense of touch :  
**PALPABLE** b : substantially real : MATERIAL
- 2 :      capable of being precisely identified or realized by the mind <her grief was tangible>
- 3 :      capable of being appraised at an actual or approximate value  
<tangible assets>

It is submitted that a data modulated signal is capable of being perceived through the use of suitable circuitry such as found in a cell phone (for example) and is therefore real in the sense that it can be detected and therefore exists; it is capable of being precisely identified (such as through the use of suitable circuitry – such as a cell phone or the like); and further capable of being appraised at an actual or approximate value when the signal is decoded by suitable receiving circuitry.

Second, claim 13 calls for:

**Electrical signals transmitted on a cellular wireless communication system that are modulated with information to implement the sending and receiving steps of claim 1.** (Emphasis added)

Thus, it is not merely claiming signals, but tangible information modulated signals which implement the sending and receiving operations recited in claim 1. Claim 1 calls for receiving order data from a customer's wireless terminal. This data, in accordance with claim 13, is, at least in part, transmitted in the form of the information modulated cellular wireless electrical signals. Thus, the position that electrical signals are not being received or transmitted, is also not correct.

Inasmuch as the § 101 rejection is based on the erroneous premise that electrical signals are non-tangible, it is submitted that, for at least this reason the § 101 rejection is untenable should be withdrawn.

Rejections under 35 USC § 102

The rejection of claims 1-3, 5 and 10-13 are rejected under 35 USC § 102(e) as being anticipated by Wood et al. This rejection is traversed.

The Wood et al. reference does not disclose each and every one of the claimed steps. For example, at paragraph #9a it is incorrectly asserted that page 3, paragraph 0032 discloses "one or more positions on the customer's anticipated route of travel" (emphasis added). However, this paragraph discloses:

[0032] In one form, it is envisaged that the shopping basket be displayed on a client device with associated delivery times available on-line displayed also. The customer could view a percentage value indicating how full the delivery time slots are, and how many other client devices are on-line. It is also anticipated that a user on a client device may check delivery status, and whether goods have been uplifted yet from a delivery agent, for example. **The user could also specify multiple delivery addresses and choose the address most desirable for the user**, with an error presented to a user if an address is chosen to which it cannot be delivered from certain merchants. The shopping cart could check individual merchant open/close times for the delivery time requested and could also check when multiple merchant orders have been placed for individual store open/close times, for example checking a store's food preparation times, open/close times, driver availability times and the like, before offering a delivery time slot to a customer. It is also envisaged that the customer could order from two or more

merchants and request delivery at the same time with the one payment. (Emphasis added)

There is no disclosure of "an anticipated route of travel." All that is disclosed is the ability to select from multiple delivery addresses. Without disclosure of the claimed "anticipated route of travel" there is no anticipation. It is further submitted that it is not possible to advance an argument that the multiple delivery addresses could be interpreted as an "anticipated route" along which the receiving party is "intending" to travel. Addresses connote fixed locations which do not move and there is no suggestion that these addresses are located along any form of predetermined route.

For at least the above reasons, it is submitted that a *prima facie* case of anticipation has not been established and the rejections based on 35 USC § 102(e) should be withdrawn.

#### Rejections under § 103

The rejection of claims 4 and 6-9 under 35 USC § 103(a) as being unpatentable over Wood et al. in view of O'Meara et al. is respectfully traversed.

In this rejection, it is admitted that Wood et al. fails to disclose calculating the route based on travel constraints, and to update the route of the rendezvous position based on the location of the customer and carrier. To overcome this acknowledged shortcoming, O'Meara et al. is cited.

However, this rejection is untenable for at least the reason that Wood et al. fail to disclose or suggest any particular delivery route whatsoever. In fact, the only usage of "route" in Wood et al. is made in connection with routing orders to the delivery agent who then is apparently left to his or her own devices as to how to get to the single address which has been selected. Thus, even if the teachings of O'Meara et al. were considered, still the claimed subject matter would not result for at least this reason. Accordingly, a *prima facie* case of obviousness is not established.

The rejections of claims 4 and 6-9 should be reconsidered and withdrawn.

Conception of the Invention

In connection with the position taken with respect to the Affidavits (more accurately declarations) submitted under 37 CFR 1.131, that the submitted documents amount to insufficient evidence to establish the invention prior to the effective date of the Wood et al. reference, it is submitted that the applicant has demonstrated the conception by a complete disclosure to another. Attention is called to the fact that the applicant has submitted a copy of a written description (see Exhibit A) evidencing conception of the invention to Ms Laurie Gathman prior the PCT filing date to which Wood et al. is entitled.

The rejection contains a statement that "every limitation in the claims are not shown in the evidence of either of the affidavits. However, this is but one of a number of criteria which are set forth in MPEP 2138.04 and this Office Action is silent with respect to the content of Exhibit A which was prepared prior the PCT filing date to which Wood et al. is entitled.

Further, this requirement appears to be an adaptation of the ruling in *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) wherein the limitations in question are set forth in a "count" – a claim which is drawn up during an interference and used to define subject matter common to an application and a patent which have been deemed by the PTO to present a double patenting problem. This case is, in this instance, not seen as being on point, especially, when a variety of other (and more applicable) requirements are cited in MPEP 2138.04.

Reference is had to MPEP 715.07 (see also Appendix A which is appended to the end of this response) wherein it is stated:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), **it does not**

**necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974). (Emphasis added)**

In this situation, there is no interference and no "count" and therefore no particular reason for the above mentioned set of criteria to be singled out for application. It is therefore submitted that a document setting forth the claims and using the same language as used in the claims is, as is apparently inferred, not required. All that is required, in accordance with the criteria which has been asserted in this Office Action, is a showing of the conception a party was in possession of every feature claimed, and that every limitation was known to the inventor at the time of the conception. The Applicant again draws attention to Exhibit A which forms part of the declaration submission.

Reference is had to the MPEP to better understand the various and varied criteria which can be relied upon to show conception.

#### 2138.04 "Conception" [R-1] - 2100 Patentability

Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice.." *Townsend v. Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive

experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v. Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."); *Hitzeman v. Rutter*, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (Inventor's "hope" that a genetically altered yeast would produce antigen particles having the particle size and sedimentation rates recited in the claims did not establish conception, since the inventor did not show that he had a "definite and permanent understanding" as to whether or how, or a reasonable expectation that, the yeast would produce the recited antigen particles.).

It is submitted that all of the claimed features can in fact be distilled from the evidence (when taken as whole) that has been presented. This should also be tempered with a more recent decision *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) which indicates that conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice."

If this is challenged then the Examiner is requested to detail those features which are not disclosed either explicitly or implicitly to the degree that a person of skill in

the art would be able to comprehend same and this should take the disclosure found in Exhibit A, into account.

In connection with the assertion that there is insufficient evidence to establish diligence, the Examiner has clearly challenged the statement "I believe that I began drafting . . ." with language, the tenor of which is suited only for the rebuttal of attorney argument. The applicant has "declared" on penalty of fine or imprisonment that he verily believes that the drafting began on Monday December 10. The insinuation which is imported via the question "did he actually begin drafting . . . or was it just an estimate", is both improper and beyond the Examiner's station.

The assertion that there is a need to show diligences for every day in the time period required that diligence be performed is challenged. MPEP 2138.06 does not support this quasi "absolute diligence" position.

#### MPEP 2138.06 "Reasonable Diligence" [R-1] - 2100 Patentability

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) ( 37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369

(CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that

patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course.."). (Emphasis added)

Note is had at least to the effect of the September 11, terrorist attack which is mentioned in the submitted evidence.

Reconsideration of the declarations which have been entered as evidence is requested. Withdrawal of the Wood et al. reference is also submitted as being proper in that the Applicant has sworn behind the earliest date to which the Wood et al. reference is entitled.

#### Conclusion

It is respectfully submitted that a *prima facie* case of anticipation has not been established, a *prima facie* case of obvious has not been established, and proper reasons for refusing the evidence that has been submitted establishing a date of conception which is earlier than the earliest date to which the Wood et al. reference is entitled, have not been advanced. It therefore submitted that all of the pending claims must be considered to be allowable. Favorable reconsideration and allowance of this application is therefore courteously solicited.

Respectfully submitted,

By \_\_\_\_\_

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APPENDIX A

MPEP 715.07 Facts and Documentary Evidence [R-2]

> I. < GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);
- (H) Disclosure documents ( MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at

718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

> II. < ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.

However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

> III. < THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, \*\*>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If

applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection.

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

For the most part, the terms "conception," "reasonable diligence," and "reduction to practice" have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. *In re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); *In re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or

declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Form paragraph 7.59 or 7.63 (both reproduced in MPEP § 715) may be used where insufficient evidence is included in a 37 CFR 1.131 affidavit.